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a gift disposed within said egg-shell shaped housing;
a detection means coupled to said egg-shell shaped housing for detecting interaction with said egg-shell shaped housing;
a microprocessor means coupled to said housing and electronically-coupled to said detection means for generating a pre-programmed signal with respect to said interaction;
a sense-detectible signal generating means electronically coupled to said microprocessor means for generating a sense-detectible signal in response to said pre-programmed signal from said microprocessor means.

REMARKS

RESPONSE TO REJECTIONS

35 U.S.C. §112 Rejections

The Examiner has rejected claims 1 - 3 and 5 - 15 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner notes that Claim 1 as filed lacked antecedent basis at line 12 for the recitation "said microprocessor," at line 10 lacks proper clarification of the recitation "[t]he type," and at line 12 makes use of the ambiguous phrase "said the signal." Similarly, the Examiner notes that claim 5 lacks antecedent basis for the recitations of "said packaging material" and "said microprocessor." Applicant remarks that while cancellation of claims 1 and 5, without prejudice, obviates the Examiner's §112 rejections with respect thereto, that Applicant has taken the Examiner's constructive observations into account in the

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drafting of new claims 16 and 17. As claims 2 and 3 now depend from claim 16, and claims 6 -15 from claim 17, both of which are asserted to lack such errata, Applicant asserts that Examiner's §112 rejections with respect to these claims are also obviated.

The Examiner has noted that claim 15 as filed erroneously recited "heat-labile" rather than --heat-labile-- and further has asserted that its recitation of "the construction" is vague and lacking antecedent basis. Amendment of claim 15 to delete the phrase "the construction" and to correct the obvious typo with respect to "liable" is believed by applicant to overcome Examiner's §112 rejections with respect to claim 15.

35 U.S.C. §102 Rejections:

The Examiner has rejected claims 1 - 4 under 35 U.S.C. §102(b) as being anticipated by the prior art. The Examiner argues that claims 1 and 2 are "clearly" anticipated by U.S. Patent No. 5,182,872 to Lee et al. (paragraph 4, page 2 of the Office Action), claim 3 by U.K. Patent No. 1,540,822 to Martlew, and claim 4 by U.S. Patent No. 5,184,971 to Williams. Applicant respectfully traverses these rejections arguing that none of the references recites all of the elements of any of the claims as originally filed. With respect to claim 1, and claims 2 and 3 which are dependent thereon, applicant further asserts that cancellation of claim 1, without prejudice, obviates Examiner's §102 rejections thereto.

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Applicant asserts that claim 4 as amended clearly defines over the prior art of record, that is the Williams reference. Applicant first notes that the Williams reference is directed solely to an apparatus and does not teach a method of manufacture, as set forth in amended claim 4. Further, applicant argues that the Martel reference teaches a toy audio recorder in the shape of a telephone and teaches nothing about placing a plurality of detection means within a packaging means as defined in amended claim 4.

With respect to new claim 16 which defines an embodiment of the embodiment claimed in cancelled claim 1, applicant notes that the neither the Lee nor Martel reference, which were cited against claims 1 and 4 as filed, suggest coupling either a detection means or microprocessor means to a packaging means as defined in claim 16. The Lee reference teaches application of a sound producing control switch only to a picture-frame (claim 1), while the Martel reference similarly teaches sound reproducing means being fixed to or accommodated in the frame (col. 1, ln. 29 - 30). New claim 16 more clearly defines a packaging means in terms of the grouping of: a box, an enclosing shell, a bag, wrapping paper, ribbon material.

In light of the above arguments, applicant respectfully requests the Examiner to withdraw Examiner's §102(b) rejections.

35 U.S.C. §103 Rejections

The Examiner has rejected under 35 U.S.C. §103 as being unpatentable: claim 5 over U.S. Patent No. 4,221,927 to Dankman et al. in view of U.S. Patent No. 4,964,831 to Wolff, claims 6 and 7 over

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U.S. Patent No. 4,221,927 to Dankman et al. in view of U.S. Patent No. 4,964,631 to Wolff as applied to claim 5 and further in view of U.S. Patent No. 4,904,988 to Nesbit et al., claims 8 -10 over U.S. Patent No 4,221,927 to Dankman et al. in view of U.S. Patent No. 4,964,531 to Wolff as applied to claim 5 and further in view of U.S. Patent No. 5,451,180 to Chan et al., claim 11 over U.S. Patent No. 4,221,927 to Dankman et al. in view of U.S. Patent No. 4,964,831 to Wolff as applied to claim 5 and further in view of U.S. Patent No. 5,055,084 to Jokic, and claims 12 -14 over U.S. Patent No. 4,221,927 to Dankman et al. in view of U.S. Patent No. 4,964,631 to Wolff as applied to claim 5 and further in view of U.S. Patent No. 5,083,961 to Ishiwa. Applicant respectfully traverses all of these rejections arguing that none of these references taken either singularly, or in combination, suggest the embodiments of the present invention set forth in the respective claims.

While applicant asserts that cancellation of claim 5, without prejudice, obviates Examiner's §103 rejections not only to claim 5, but also to claims 6 - 15 that depend therefrom, in order to streamline the prosecution in this matter, applicant sets forth remarks concerning the Examiner's §103 rejections in regard to new claim 17 which defines further the embodiment of cancelled claim 5.

Applicant argues that Examiner's contention that "[i]t would have been obvious to one of ordinary skill in the art to have provided a Dankman toy with an internal gift as taught by Wolff" entails impermissible hindsight and suggests the combination of two art

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references that fail to recognize in the slightest way the problem addressed by the present invention.

The Wolff reference teaches distributing collector dolls in a casing that "may be substantially spherical in shape and formed by two halves that are joined together." (Col. 2, ln. 1 - 2) The Dankman et al. reference on the other hand illustrates a toy with a spherical body "having portions [] corresponding to eyes and a portion [] corresponding to a mouth." (Col. 1, ln. 55 - 56) Neither reference suggests in any manner that the anticipation of opening a gift may be heighten by using light or sound generating sources electronically associated with the packaging material, as in the present invention. (page 3, ln. 19 - 22) In fact Dankman uses his egg-shaped package in a simple conventional manner to hold and hide from purview the gift inside. The Wolff reference is respectfully not suggestive at all of placing a gift within the housing of the toy, as the electronics of the toy are illustrated as being incorporated therein. Applicant respectfully further argues that the roundness of the Wolff toy is expected given the inventor's desire to have portions of the toy corresponding to eyes and a mouth. The postulate that the roundness of the Dankman et al. toy would suggest to a person of ordinary skill in the art to look at egg-shaped packaging, and then to incorporate therein the electronic attributes of the Dankman et al. toy into such packaging material is respectfully impermissible hindsight. The prior art lacks any suggestion for such combination.

With respect to Examiner's citation to U.S. Patent No. 4,904,988 to Nesbit et al. in regard to dependent claims 6 and 7, and

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to U.S. Patent No. 5,451,180 to Chan et al. with respect to dependent claims 8 - 10, and to U.S. Patent No. 5,055,084 to Jokic with respect to claim 11, and U.S. Patent No. 5,083,961 to Ishiwa with respect to claims 12 - 14, applicant notes that all such references are cited in combination with the Dankman et al. and Wolff references, which for the reasons set forth above are not suggestive of the present invention. Therefore, applicant asserts that all of these claims as well can not be said to be made obvious by the art of record. Applicant respectfully asserts that citation to these references compounds impermissible hindsight. The Nesbit et al. reference teaches a toy with a smoke detector, while the Ishiwa reference teaches a toy with a bag unit that flies out of the interior of the toy when gas is generated (col. 1, ln. 6 - 8) -- neither are suggestive of using heat-sensitive detectors or gas-generating devices to enhance the anticipation of opening a gift. The Chan et al. reference teaches an egg-shaped housing with a scene board mounted on the housing (claim 1 and 10, figure 1) while the Jokic reference teaches using a spring to push a message forward upon opening a box. As with the Nesbit et al. and Ishiwa references, neither reference is suggestive of electronic enhancement to the packaging to provide for enhanced anticipation in opening a gift as set forth in the present invention.

In order to combine references, the prior art must suggest the combination. No where in the references is there provided a motivation for the combination. Accordingly, the prior art references of record, singularly and in combination, fail to disclose, suggest or

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teach the present invention. Applicant respectfully requests withdrawal of the rejection.

New Claims

New independent claim 16 and 17 are presented to more completely cover certain aspects of the invention.

New independent claim 16 recites a package amusement device comprising: a packaging means for packaging a gift, said packaging means selected from the group of: a box, an enclosing shell, a bag, wrapping paper, ribbon material; a detection means coupled with said packaging means for detecting interaction with said packaging means; a microprocessor means coupled to said packaging means and electronically connected to said detection means for generating a pre-programmed signal with respect to said interaction; a sense-detectible signal generating means electronically connected to said microprocessor means for generating a sense-detectible signal in response to said pre-programmed signal from said microprocessor means. Support for new independent claim 16 is found, among other places, former claim 1, page 6, ln. 10 - 13, page 2, ln. 23 - 26 and Figure 4. Claim 16 is felt to clearly distinguish itself from the art of record for the reasons set forth above.

New independent claim 17 recites an egg-shell shaped package amusement device, comprising: an egg-shell shaped housing; a gift disposed within said egg-shell shaped housing; a detection means

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coupled to said egg-shell shaped housing for detecting interaction with said egg-shell shaped housing; a microprocessor means coupled to said housing and electronically-coupled to said detection means for generating a pre-programmed signal with respect to said interaction; a sense-detectible signal generating means electronically coupled to said microprocessor means for generating a sense-detectible signal in response to said pre-programmed signal from said microprocessor means. Support for claim 17 is found, among other places, former claim 5, page 5, ln. 14 - 16, page 8, ln. 14 - 16, page 9, ln. 4 and Figures 4 and 5 . Claim 17 is felt to clearly distinguish itself from the art of record for the reasons set forth above.

CONCLUSIONS

Accordingly, it is respectfully submitted that the claims under consideration are clearly patentable over the references of record. It is submitted that the above-identified patent application is in condition for allowance. Early notification of the allowability of claims 2 - 3 and 6 - 17 is courteously solicited.

FEES

No fee is due.

Respectfully submitted,

Dated: _____

Steven J. Moore
Applicant